REMARKS/ARGUMENTS

Reconsideration of this application, in view of the foregoing amendment and the following remarks and arguments, is respectfully requested.

Claims 1-8 and 10-12 are currently pending in this application. By the foregoing amendment, Claim 1 has been revised, and new Claims 13-16 have been added to afford the applicants the breadth and scope of patent protection to which they are entitled. Accordingly, Claims 1-8 and 10-16 are now present in this application for consideration and allowance.

In the April 28, 2008 Office Action the following objection and rejection, which are respectfully traversed for reasons subsequently set forth herein, were made.

> 1. The Examiner has objected to applicants' claim to priority from prior-filed U.S. applications serial no. 09/088459 and serial no. 09/420,529; and
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> 2. Claims 1-8 and 10-12 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 4,969,888 to Scholten et al in view of U.S. Patent 4,467,790 to Schiff.

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1. The Priority Claim Objection

Although applicants disagree with this objection, it is seen to be moot in view of the effective dates of the Scholten et al and Schiff references currently being relied upon by the Examiner.

2. The Obviousness Rejection of Claims 1-8 and 10-12

For the Examiner's convenience, amended Claim 1 is set forth below:

1 A method for treating bone comprising:

providing a tubular assembly comprising a first tubular member having a distal end, a second tubular member extending along an axis, longitudinally extending through the interior of the first tubular member, and having a distal end projecting outwardly beyond the distal end of the first tubular member, and a torque transmitting stylet

longitudinally extending through the interior of the second tubular member and having a distal end anchored to the distal end of the second tubular member,

providing a structure having opposite ends spaced along ~~an~~ **the** axis, the structure being adapted to undergo expansion outwardly about the axis, the structure having a normally unwrapped condition having an outside diameter,

securing one end of the structure to the distal end of the first tubular member, and the other end of the structure to the outwardly projecting distal end of the second tubular member, in a manner such that the structure substantially envelopes the outwardly projecting distal end of the second tubular member,

placing the structure in a wrapped condition by **rotating the stylet to thereby rotate the second tubular member relative to the first tubular member and wrap** the structure inwardly about the **outwardly projecting distal end of the second tubular member** to reduce the outside diameter,

inserting the structure, while in the wrapped condition, into bone,

returning the structure to the unwrapped condition inside bone, and

causing expansion of the structure in cancellous bone.

Neither of the Scholten et al and Schiff references discloses or in any manner suggests the method step in Claim 1 of "providing a tubular assembly comprising a first tubular member extending having a distal end, a second tubular member extending along an axis, longitudinally extending through the interior of the first tubular member, and having a distal end projecting outwardly beyond the distal end of the first tubular member, and a torque transmitting stylet longitudinally extending through the interior of the second tubular member and having a distal end anchored to the distal end of the second tubular member". Specifically, neither reference discloses or suggests telescoped first and second tubular members with a torque transmitting stylet extending through the inner tube and being anchored to its distal end.

Further, neither of the Scholten et al and Schiff references discloses or in any manner suggests the method step in Claim 1 of securing one end of an expandable structure "to the distal end of the first tubular member, and the other end of the structure to the outwardly projecting distal end of the second tubular member, in a manner such that the structure substantially envelopes the outwardly projecting distal end of the second tubular member". In Scholten et al, the balloons 65 and 76 are not secured at opposite ends thereof to telescoped first and second tubular members, but are simple extended through the single tubular cannula member 30. In Schiff, there is only a single tubular member (16), and the balloon 12 is not secured at its distal end to the distal end of a second tubular member, but is instead secured directly to the stylet 30 extending through the single tubular member 16. Moreover, none of the illustrated expandable members in Scholten et al and Schiff substantially envelopes an outwardly projecting distal end of a second tubular member extending through a first tubular member as required by Claim 1.

Additionally, in neither of the Scholten et al and Schiff references is there a teaching or suggestion of applicants' claimed method step of "placing the structure in a wrapped condition by rotating the stylet to thereby rotate the second tubular member relative to the first tubular member and wrap the structure inwardly about the outwardly projecting distal end of the second tubular member to reduce the outside diameter [of the structure]". In Scholten et al there is no disclosure or suggestion of wrapping of an expandable structure, and in Schiff the balloon 12 is wrapped around the stylet 30 - not a tubular member through which the stylet extends and is drivingly connected to. Finally, neither of the Scholten et al and Schiff references discloses or suggests the use of a stylet to rotationally drive a tubular member to which an expandable member is secured as specified in Claim 1.

For at least the foregoing reasons it is respectfully submitted that Claim 1, and Claims 2-8 and 10-12 which depend therefrom, are patentably distinguishable over U.S. Patent 4,969,888 to Scholten et al and U.S. Patent 4,467,790 to Schiff whether these two references are considered singly or in any combination thereof.

3. <u>New Claims 13-16</u>

Each of applicants' newly presented Claims 13-16 depends from allowable Claim 1 and, for at least this reason is seen to be allowable over the Scholten et al and Schiff references. At

least Claim 16 is seen to allowable for the further reason that it recites the step of expanding the recited expandable structure in cancellous bone by "flowing an expansion fluid through the annular flow passage into the interior of the structure", such annular flow passage being specified as being ."created between the first and second tubular members". Neither of the Scholten et al and Schiff references discloses or in any manner suggests this claimed annular flow passage created between two telescoped tubular members.

In view of the foregoing amendment, remarks and arguments, all of the claims currently pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of Claims 1-8 and 10-16 is therefore earnestly solicited.

The Examiner is hereby requested to telephone the undersigned attorney of record at 972/739-8612 if such would further or expedite the prosecution of the instant application.

Respectfully submitted,

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Dated: October 16, 2008

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Client Matter No. P0031798.156
010-008US06
41914.463

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